

**REMARKS**

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.116, and in light of the remarks which follow, are respectfully requested.

Claims 17 and 35 have been amended in response to issues raised in the Office Action. Claims 17-30 and 33-38 remain pending in this application.

Claims 17-30, 33, 34, 36 and 37 were rejected under 35 U.S.C. §112, second paragraph, for the reasons set forth in paragraph (1) of the Office Action. Reconsideration of this rejection is respectfully requested for at least the reasons which follow.

The legal standard for determining compliance with the second paragraph of 35 U.S.C. §112, is whether the claims reasonably apprise those of ordinary skill in the art of their scope. See In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). In determining whether this standard is met, the definiteness of the language employed in the claim must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

When those of ordinary skill in this art analyze the language of the claims in light of the description in the specification and in light of their own knowledge and experience in the art, the scope of the claims would be clear and definite. The "lowest temperature" as

in the last line of claim 17 refers to the deblocking temperature of the first group to deblock. This is clear from the specific working examples on pages 19-23.

The language "very close" is a term of degree. When a term of degree is used, one must look to the specification to determine whether some standard has been provided to measure that degree. In the present case, the specification discloses that the release temperature as determined by the octanol test is the lowest temperature at which a significant portion (usually 90%) of the blocked isocyanate is released (page 18). The overall release temperature of the claimed composition approximates the temperature of the group which deblocks first. Thus, those of ordinary skill would understand that the overall release temperature should be equal to or close enough to the lowest temperature such that a significant portion of the block isocyanate groups are released. Accordingly, the present specification provides a standard to those of ordinary skill to readily determine how close the overall release temperature must be to the lowest temperature in order to achieve the objectives of the invention.

Based on the above comments, it is submitted that the §112, second paragraph, rejection of claims 17-30, 33, 34, 36 and 37 should be withdrawn. Such action is earnestly requested.

Claims 21, 23, 24 and 27 have been rejected under 35 U.S.C. §112, second paragraph, for the reason given in paragraph (2) of the Office Action. Since Applicants have deleted the proviso added by the Amendment filed March 12, 2003, this rejection has been rendered moot and should be withdrawn.

Claims 17-30 and 33-38 stand rejected under 35 U.S.C. §112, first paragraph, for reasons given in paragraph (3) of the Office Action. Although Applicants disagree with the Examiner's position, the proviso added to claims 17 and 35 by the Amendment filed March 12, 2003, has been deleted without prejudice or disclaimer solely to expedite prosecution. Thus, this rejection should now be withdrawn.

Claims 17-25, 28-30 and 33-36 were rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,523,377 to König et al for the reason provided in paragraph (5) of the Office Action. Reconsideration of this rejection is respectfully requested in view of the aforementioned amendments and for at least the following reasons.

The '377 patent discloses using a mixture of 1,2,4-triazole and butanone oxime (methyl ethyl ketoxime). The present claims by virtue of the newly added proviso, now exclude this combination of blocking agents. Accordingly, the §102(b) rejection has been obviated and should be withdrawn.

Claims 26 and 27 were rejected under 35 U.S.C. §103(a) as unpatentable over König et al '377 for reasons set forth in paragraph (7) of the Office Action. Reconsideration and withdrawal of this rejection are requested in view of the above amendments to the claims and for at least the reasons will follow.

The teachings of König et al '377 relate specifically to combinations of butanone oxime and 1,2,4- triazole to combat the yellowing of coatings prepared by reacting the blocked polyisocyanates with polyhydroxy compounds. The yellowing is caused when the oxime is used as the sole blocking agent. There is no disclosure that other oximes cause

the yellowing problem. Those of ordinary skill in this art could not reasonably predict that oximes other than the one specifically disclosed in the reference would also cause yellowing of coatings and that the yellowing could be minimized by adding 1,2,4-triazole. The absence of any disclosure or suggestion in König et al '377 of other oximes is noteworthy.

Moreover, Applicants have discovered that the release temperature of polyisocyanates blocked with oximes and triazoles is equal to or close to that of the group released first, an unexpected result not disclosed or suggested in the reference. Even if those of ordinary skill might expect that other oximes could be mixed with 1,2,4-triazole to avoid yellowing, one could not predict that the release temperature of the blocked polyisocyanates would approximate that of the group released first, i.e. at the lowest temperature.

For at least the above reasons, the §103(a) rejection over König et al '377 should be withdrawn. Such action is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at his earliest convenience.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: November 4, 2003

By: George F. Lesmes  
George F. Lesmes  
Registration No. 19,995

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620